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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/378,318	08/20/1999	GERALD D. TREADWAY	35294.3.5	8966

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EXAMINER

MULCAHY, PETER D

ART UNIT	PAPER NUMBER
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1713

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DATE MAILED: 03/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/378,318

Applicant(s)

TREADWAY, GERALD D.

Examiner

Peter D. Mulcahy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claims 1-18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

The rejection as set forth under 35 U.S.C. § 112 is deemed proper and is herein repeated.

Applicants' arguments have been fully considered but are deemed to be not persuasive. Applicants argue that the hydrolyzed as well as unhydrolyzed epoxy functional alkoxysilanes are described in the specification and that the affirmative inclusion of the unhydrolyzed silane provides a variety of advantages. Applicants conclude that the Examiner's concerns regarding a partially hydrolyzed compound are rendered moot. This is not persuasive. Applicants should note that the claims are not limited by the specification and it is a requirement of § 112 second paragraph that the claim be definite so as to render the metes and bounds of the claimed invention clearly established. The Examiner maintains that a partially hydrolyzed compound would fall within the scope of the instantly claimed hydrolyzed as well as unhydrolyzed. Applicants have failed to allege or show that such is not the case. As such, the claim language is seen to overlap in scope and is therefore indefinite. It is simply unclear as to how many ingredients are to be added to the claimed invention.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Funaki et al.

The rejection as set forth under 35 U.S.C. § 103 over Funaki is herein maintained. Applicants' newly amended claims as well as the remarks filed in support thereof have been fully considered but have been deemed to be not persuasive.

Applicants argue that the Funaki et al. patent fails to describe the inclusion of unhydrolyzed silanes in the manner or for the purpose as presently claimed. This is not persuasive. The Funaki patent teaches the incorporation of partially hydrolyzed compounds and as such there are unhydrolyzed silane groups added to the composition. The Examiner finds no patentable distinction with respect to the "manner" that the silane is added in Funaki as compared to the presently claimed invention. The fact that the Funaki patent adds the silane for a different purpose is not relevant given that the case law has

well established that ingredients do not need to be added to compositions for the same purpose as that claimed in order to render the claimed invention prima facie obvious.

Applicants argue that the reference fails to teach the polymerization of monomers and is instead only concerned with the use of preformed polymers. This is not persuasive. Applicants have failed to show or allege any difference between the utilization of the polymers as in Funaki compared to the polymers which are in fact formed in the presently claimed invention.

Claims 1-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Morrison or Tarshiani et al. taken in view of Perkins et al.

The rejection as set forth under 35 U.S.C. § 103 on pages 3 and 4 of Paper No. 2 is deemed proper and is herein repeated.

Applicants' newly amended claims as well as the remarks filed in support thereof have been fully considered but have been deemed to be not persuasive.

Applicants argue that both Morrison and Tarshiani et al. fail to show the incorporation of an unhydrolyzed silane component. This is not persuasive. The incorporation of the prehydrolysis product of the epoxysilane in Morrison is clearly suggestive of an unhydrolyzed silane. A hydrolyzable alkoxysilane also teaches the incorporation of an unhydrolyzed alkoxysilane. With respect to the incorporation of polymerizable

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monomers in combination with the epoxy compounds, the Perkins patent is cited as showing the incorporation of monomers in epoxysilane coating applications. Applicants have failed to show or allege any unexpected results due to the specifically claimed invention.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy, whose telephone number is (703) 308-2449. The examiner

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can normally be reached on Tuesday through Friday from 7:30 A.M. to 6:00 P.M.

The fax telephone number for this group is (703) 305-3599.

Any inquiry of general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.

P. Mulcahy:cdc
February 28, 2002



**PETER D. MULCAHY
PRIMARY EXAMINER
GROUP 1500**